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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO.       |
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| 10/690,653  | 10/21/2003  | Shiping Wang         | GL-6171                      | 5864                   |
| Kim Luna<br>1430 Waukegan Road<br>McGaw Park, IL 60085-6787 |             |                      | EXAMINER<br>BERNATZ, KEVIN M |                        |
|   |             |                      | ART UNIT<br>1773             | PAPER NUMBER           |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/690,653 | <b>Applicant(s)</b><br>WANG ET AL. |  |
|                              | <b>Examiner</b><br>Kevin M. Bernatz  | <b>Art Unit</b><br>1773            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 18-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Preliminary amendments to claims 18, 34 and 35, filed on January 29, 2007 and April 27, 2007, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Examiner's Comments***

3. Regarding the limitation(s) "an elastomeric layer having a skin-contacting surface" in claims 18 - 36, the Examiner has given the term(s) the broadest reasonable interpretation(s) consistent with the written description in Applicants' specification as it would be interpreted by one of ordinary skill in the art. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Donaldson Co., Inc.*, 16 F.3d 1190, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994). See MPEP 2111. Specifically, the Examiner notes that the "skin-contacting surface" does not actually contact the skin since the coating composition is applied on the "skin-contacting surface". As such, the Examiner has interpreted the "skin-contacting surface" to more accurately be referred as the "skin-facing" surface, since it is the surface that is closest to the skin when the elastomeric article is placed in contact with the skin. For clarity, Applicants are suggested to reword the claims to clarify that the "skin contacting" surface of the elastomeric article does not technically contact the skin.

### ***Request for Continued Examination***

4. A Request for Continued Examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 29, 2007 has been entered. An action on the RCE follows.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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6. Claims 18 – 24, 26, 27, 29 – 31 and 33 - 36 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16 - 32 of copending Application No. 10/882,580 (App '580). Although the conflicting claims are not identical, they are not patentably distinct from each other because App '580 claims an elastomeric article possessing a coating composition meeting the claimed limitations, including comprising at least one polyhydric alcohol (*e.g. claims 17, 26 and 27*) and at least one alphahydroxy lactone (*e.g. claims 25, 28 and 29*). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding the limitation(s) of claims 19 – 24, 27 and 33 (weight percents), the Examiner notes that the disclosure of App '580 teach(es) that the claimed invention is an obvious variation of the disclosed invention (*pages 8 - 10*).

Applicants are reminded that while it is generally prohibited from using the disclosure of a potentially conflicting patent or application in an Double Patenting analysis, there are two exceptions permitted by the MPEP. Specifically, "those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent". In the instant case the above relied upon disclosure supports the claimed limitations by providing specifics of the generally claimed chemical compounds and/or appropriate weight percent ranges in order to make and/or use the claimed invention.

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7. Claims 25, 28 and 32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16 - 32 of copending App '580 as applied above, and further in view of Mansouri (U.S. Patent App. No. 2001/0006680 A1). This is a provisional obviousness-type double patenting rejection.

Regarding claims 25 and 28, App '580 is relied upon as described above.

App '580 fail to disclose adding pantothenol meeting Applicants' claimed limitations.

However, Mansouri teaches that it is known in the art to add vitamins, including pantothenol (*which the Examiner notes is the provitamin B form per Applicants' specification, page 10, lines 1 - 18*) to skin care lotions in order to provide vitamin enhancement to a person's skin (*Paragraph 0125*).

It would, therefore, have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to modify the device of App '580 to include pantothenol in provitamin B form as taught by Mansouri, since such an addition is known in the art and would result in vitamin enhancement to a person's skin.

Regarding claim 32, App '580 disclose materials which are deemed to function as plasticizers (*claims 20 - 25*).

***Claim Rejections - 35 USC § 103***

8. Claims 18 – 24, 26, 27 and 29 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soerens et al. (U.S. Patent No. 6,967,261 B1) in view of Chou '893 A1 (U.S. Patent App. No. 2003/0204893 A1) and/or Hahn et al. (U.S. Patent App. No. 2003/0124202 A1) and/or Murray et al. (U.S. Patent No. 4,920,158).

Regarding claims 18, 26 and 27, Soerens et al. disclose an elastomeric article (*col. 35, lines 33 – 49: elastomeric polyisoprene bandage*) comprising an elastomeric layer having a skin contacting surface (*col. 7, line 59 bridging col. 8, line 5 and col. 35, lines 33 – 54: base sheet*); and a coating composition on the skin-contacting surface of said elastomeric layer (*col. 5, line 51 bridging col. 6, line 24 and example 18*), said coating composition being in a dry state (*ibid and col. 32, lines 24 – 27; col. 35, line 33 bridging col. 36, line 32; and examples*) and comprising at least one polyhydric alcohol moisturizer (*examples, especially 18 and 19: glycerin*), wherein said composition is water-soluble and hydratable upon contact with skin (*examples; col. 5, line 51 bridging col. 6, line 24; col. 32, lines 24 – 27; and col. 35, line 33 bridging col. 36, line 32*).

Soerens et al. fail to teach adding at least one alphahydroxy lactone to the coating composition, though Soerens et al. does teach that additional additives are envisioned within the scope of the invention (*col. 39, lines 22 – 29*).

However, Hahn et al. teach that it is known in the art that gluconolactone meeting Applicants' claimed limitations is an exfoliants for therapeutic compositions (*Paragraphs 0002 and 0007*) and Murray et al. teach adding gluconolactone meeting Applicants' claimed limitations to a wound dressing or therapeutic skin coating material (*Title; col. 7,*

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*lines 18 – 50; and col. 8, lines 22 - 31)* for use as a drying aid, plasticizer, and/or aesthetic purposes (*col. 6, lines 3 – 9; col. 6, lines 44 – 59; col. 7, lines 9 – 50; col. 8, lines 8 – 21; col. 12, lines 36 – 39; and examples*). Finally, Chou '893 A1 disclose adding hydroxyacids substantially identical to those disclosed by Hahn et al. for use in a therapeutic coating composition (*Paragraphs 0037 – 0046*). The Examiner notes that gluconolactone meeting Applicants' claimed limitations is a derivative of glucuronic acid/glucoric acid, which is disclosed by Chou '893 A1 (*Paragraphs 0037 and 0046*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the Applicant(s) invention to modify the device of Soerens et al. to include an exfoliants such as gluconolactone in the coating composition as taught by Hahn et al., and/or Murray et al. and/or Chou '893 A1, since such an additive can serve as an exfoliants, a drying aid, a plasticizer or simply for aesthetic purposes.

Regarding claims 19 – 22, the Examiner notes that Soerens et al. disclose elastomeric base sheets (*col. 7, line 59 bridging col. 8, line 5 and col. 35, lines 33 – 54*), wherein the Examiner takes Official Notice that the claimed specific elastomeric materials are known in the art as elastomeric materials useable to make films for skin-contacting articles.

The limitation(s) in claims 23 and 24 are intended use limitation(s) and are not further limiting in so far as the structure of the product is concerned. Note that "in apparatus, article, and composition claims, intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is***



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***capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art." [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02. In the instant case, the Examiner notes that the disclosed elastomeric coating composition (while in the form of a bandage) could be formed in the form of a glove, if desired.

Regarding claims 29 and 30, Soerens et al. disclose adding film-forming polymers meeting Applicants' claimed limitations (*col. 4, line 22 bridging col. 5, line 28 and examples, especially examples 18 and 19*).

Regarding claim 31, the Examiner deems that disclosed grafted-PEO, which swells upon contact with water, functions as a "hydration promoter" by providing a hydration source within proximity of the skin (*col. 8, lines 45 – 52 and example 19*).

9. Claims 25, 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soerens et al. in view of Chou '893 A1 and/or Hahn et al. and/or Murray et al. as applied above, and further in view of Mansouri ('680 A1).

Regarding claims 25 and 28, Soerens et al., Chou '893 A1, Hahn et al. and Murray et al. are relied upon as described above.

None of the above disclose adding pantothenol meeting Applicants' claimed limitations.

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However, Mansouri teaches that it is known in the art to add vitamins, including pantothenol (*which the Examiner notes is the provitamin B form per Applicants' specification, page 10, lines 1 - 18*) to skin care lotions in order to provide vitamin enhancement to a person's skin (*Paragraph 0125*).

It would, therefore, have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to modify the device of Soerens et al. in view of Chou '893 A1 and/or Hahn et al. and/or Murray et al. to include pantothenol in provitamin B form as taught by Mansouri, since such an addition is known in the art and would result in vitamin enhancement to a person's skin.

Regarding claim 32, Soerens et al. is deemed to disclose materials which function as plasticizers (*col. 8, lines 45 – 52; examples 18 and 19: grafted-PEO and polymeric gels*).

10. Claims 18 – 24, 26, 27, 29, 31 and 33 - 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chou ('893 A1) in view of Hahn et al. ('202 A1) and/or Murray et al. ('158) and further in view of Applicants' admissions.

Regarding claims 18, 26 and 27, Chou '893 A1 discloses an elastomeric article (*Title; Abstract and Paragraphs 0022 and 0028*) comprising an elastomeric layer having a skin contacting surface (*ibid*); and a coating composition on the skin-contacting surface of said elastomeric layer (*ibid*), said coating composition being in a dry state (*ibid*) and comprising at least one polyhydric alcohol moisturizer (*Paragraph 0032*:

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*glycerin*), wherein said composition is water-soluble and hydratable upon contact with skin (*Title; Abstract and Paragraphs 0022 and 0028*).

Chou '893 A1 fails to teach adding at least one alphahydroxy lactone to the coating composition, though Chou '893 A1 does teach that additional additives are envisioned within the scope of the invention (*Paragraph 0084*).

However, Hahn et al. teach that it is known in the art that gluconolactone meeting Applicants' claimed limitations is an exfoliants for therapeutic compositions (*Paragraphs 0002 and 0007*) and Murray et al. teach adding gluconolactone meeting Applicants' claimed limitations to a wound dressing or therapeutic skin coating material (*Title; col. 7, lines 18 – 50; and col. 8, lines 22 - 31*) for use as a drying aid, plasticizer, and/or aesthetic purposes (*col. 6, lines 3 – 9; col. 6, lines 44 – 59; col. 7, lines 9 – 50; col. 8, lines 8 – 21; col. 12, lines 36 – 39; and examples*). Finally, Chou '893 A1 disclose adding hydroxyacids substantially identical to those disclosed by Hahn et al. for use in a therapeutic coating composition (*Paragraphs 0037 – 0046*). The Examiner notes that gluconolactone meeting Applicants' claimed limitations is a derivative of glucuronic acid/glucoric acid, which is disclosed by Chou '893 A1 (*Paragraphs 0037 and 0046*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the Applicant(s) invention to modify the device of Chou '893 A1 to include an exfoliants such as gluconolactone in the coating composition as taught by Hahn et al., and/or Murray et al. and/or Chou '893 A1, since such an additive can serve as an exfoliants, a drying aid, a plasticizer or simply for aesthetic purposes.

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Regarding claims 19 – 22, the Examiner notes that Chou '893 A1 disclose elastomeric base sheets including natural rubber, nitrile material, etc. (*Paragraph 0022*), wherein the Examiner takes Official Notice that the claimed specific elastomeric materials are known in the art as elastomeric materials useable to make films for skin-contacting articles.

The limitation(s) in claims 23 and 24 are intended use limitation(s) and are not further limiting in so far as the structure of the product is concerned. Note that “in apparatus, article, and composition claims, intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02. In the instant case, the Examiner notes that Chou '893 A1 disclose forming the article into gloves (*Figures*) and the exact use of the glove is deemed to be an intended use limitation.

Regarding claim 29, Chou '893 A1 disclose adding film-forming polymers meeting Applicants' claimed limitations (*Paragraph 0031*).

Regarding claim 31, Chou '893 A1 disclose hydration promoters as additives to the coating composition (*Paragraphs 0030 and 0051: where citric acid, a.k.a. sodium*

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*citrate, is admitted by Applicants' as a known hydration promoter, see specification page 13).*

Regarding claim 33, the Examiner deems that it would have been obvious to one having ordinary skill in the art to have determined the optimum value of a results effective variable such as the amount of each compound added to the coating through routine experimentation, especially given the teaching in Murray et al. regarding the use of relatively small concentrations of polyhydric alcohol (*glycerin*) and alphahydroxy lactone (*gluconolactone*) in formation of skin-contacting material (*col. 7, lines 18 – 50 and examples*). *In re Boesch*, 205 USPQ 215 (CCPA 1980); *In re Geisler*, 116 F. 3d 1465, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); *In re Aller*, 220 F.2d, 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Regarding claims 34 and 35, these claims are met for the reasons noted above with regard to claims 18, 23 and 24.

11. Claims 25, 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chou '893 A1 et al. in view of Hahn et al. and/or Murray et al. as applied above, and further in view of Mansouri ('680 A1).

Regarding claims 25 and 28, Chou '893 A1, Hahn et al. and Murray et al. are relied upon as described above.

None of the above disclose adding pantothenol meeting Applicants' claimed limitations.

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However, Mansouri teaches that it is known in the art to add vitamins, including pantothenol (*which the Examiner notes is the provitamin B form per Applicants' specification, page 10, lines 1 - 18*) to skin care lotions in order to provide vitamin enhancement to a person's skin (*Paragraph 0125*).

It would, therefore, have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to modify the device of Chou '893 A1 in view of Hahn et al. and/or Murray et al. to include pantothenol in provitamin B form as taught by Mansouri, since such an addition is known in the art and would result in vitamin enhancement to a person's skin.

Regarding claim 32, Chou '893 A1 discloses adding plasticizers/thickeners (*Paragraph 0031*).

12. Claims 30 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chou '893 A1 in view of Hahn et al. and/or Murray et al. as applied above, and further in view of Soerens et al. (261 B1).

Chou '893 A1, Hahn et al. and Murray et al. are relied upon as described above.

None of the above disclose adding chitosan to the coating composition.

However, Soerens et al. teach that chitosan is preferably added as a naturally occurring anti-microbial agent (*col. 4, line 22 bridging col. 6, line 24 and examples*).

It would, therefore, have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to modify the device of Chou '893 A1 in view of Hahn et al. and/or Murray et al. to include chitosan in the coating composition as taught by

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Soerens et al., since chitosan is known to be an additive in skin-contacting coatings as a naturally occurring anti-microbial agent.

13. Claims 18 – 29 and 31 – 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chou (U.S. Patent No. 6,953,582 B2) in view of Mansouri ('680 A1) and Chou ('893 A1) and/or Hahn et al. ('202 A1) and/or Murray et al. ('158) and further in view of Applicants' admissions.

Regarding claims 18, 26 and 27, Chou '582 B2 discloses an elastomeric article (*Title; Abstract; col. 1, line 16 bridging col. 2, line 16; and col. 3, lines 44 - 53*) comprising an elastomeric layer having a skin contacting surface (*ibid*); and a coating composition on the skin-contacting surface of said elastomeric layer (*ibid*), said coating composition being in a dry state (*ibid*), wherein said composition is water-soluble and hydratable upon contact with skin (*ibid*).

Chou '582 B2 fails to teach adding at least one polyhydric alcohol to the coating composition, though Chou '582 B2 does teach that additional additives are envisioned within the scope of the invention (*col. 8, lines 23 - 34*).

However, Mansouri teaches that it is known in the art to add polyhydric alcohol to a coating composition as either a anti-microbial agent or as a humectant (*Paragraphs 0029, 0030, 0061 – 0069: sorbitol and/or glycerin*).

It would, therefore, have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to modify the device of Chou '582 B2 to include a polyhydric alcohol meeting Applicants' claimed limitations as taught by Mansouri, since

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such a component can function as either, or both, of an anti-microbial agent and/or a humectant.

Neither Chou '582 B2 nor Mansouri teach adding at least one alphahydroxy lactone to the coating composition, though Chou '582 B2 does teach that additional additives are envisioned within the scope of the invention (*col. 8, lines 23 - 34*).

However, Hahn et al. teach that it is known in the art that gluconolactone meeting Applicants' claimed limitations is an exfoliants for therapeutic compositions (*Paragraphs 0002 and 0007*) and Murray et al. teach adding gluconolactone meeting Applicants' claimed limitations to a wound dressing or therapeutic skin coating material (*Title; col. 7, lines 18 – 50; and col. 8, lines 22 - 31*) for use as a drying aid, plasticizer, and/or aesthetic purposes (*col. 6, lines 3 – 9; col. 6, lines 44 – 59; col. 7, lines 9 – 50; col. 8, lines 8 – 21; col. 12, lines 36 – 39; and examples*). Finally, Chou '893 A1 disclose adding hydroxyacids substantially identical to those disclosed by Hahn et al. for use in a therapeutic coating composition (*Paragraphs 0037 – 0046*). The Examiner notes that gluconolactone meeting Applicants' claimed limitations is a derivative of glucuronic acid/glucoric acid, which is disclosed by Chou '893 A1 (*Paragraphs 0037 and 0046*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the Applicant(s) invention to modify the device of Chou '582 B2 in view of Mansouri to include an exfoliants such as gluconolactone in the coating composition as taught by Hahn et al., and/or Murray et al. and/or Chou '893 A1, since such an additive can serve as an exfoliants, a drying aid, a plasticizer or simply for aesthetic purposes.



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Regarding claims 19 – 22, the Examiner notes that Chou '582 B2 disclose elastomeric base sheets including natural rubber, etc. (*Title; Abstract; col. 1, line 16 bridging col. 2, line 16; and col. 3, lines 44 - 53*), wherein the Examiner takes Official Notice that the claimed specific elastomeric materials are known in the art as elastomeric materials useable to make films for skin-contacting articles.

The limitation(s) in claims 23 and 24 are intended use limitation(s) and are not further limiting in so far as the structure of the product is concerned. Note that “in apparatus, article, and composition claims, intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02. In the instant case, the Examiner notes that Chou '582 B2 disclose forming the article into gloves (*Figures*) and the exact use of the glove is deemed to be an intended use limitation.

Regarding claims 25 and 28, Mansouri teaches that it is known in the art to add both glycerin vitamins, including pantothenol (*which the Examiner notes is the provitamin B form per Applicants' specification, page 10, lines 1 - 18*) to skin care lotions in order to provide vitamin enhancement to a person's skin (*Paragraph 0125*).

Regarding claim 29, Mansouri disclose adding film-forming polymers meeting Applicants' claimed limitations (*Paragraphs 0121 - 0122*).

Regarding claim 31, Mansouri disclose hydration promoters as additives to the coating composition (*Paragraph 0129 - 0130: where citric acid, a.k.a. sodium citrate, is admitted by Applicants' as a known hydration promoter, see specification page 13*).

Regarding claim 32, Mansouri disclose adding materials which are deemed to function as a plasticizer/viscosity enhancer (*Paragraphs 0121-0122*).

Regarding claim 33, the Examiner deems that it would have been obvious to one having ordinary skill in the art to have determined the optimum value of a results effective variable such as the amount of each compound added to the coating through routine experimentation, especially given the teaching in Mansouri regarding the amount of the various additives used in skin care compositions (*examples*) and Murray et al. regarding the use of relatively small concentrations of polyhydric alcohol (*glycerin*) and alphahydroxy lactone (*gluconolactone*) in formation of skin-contacting material (*col. 7, lines 18 – 50 and examples*). *In re Boesch*, 205 USPQ 215 (CCPA 1980); *In re Geisler*, 116 F. 3d 1465, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); *In re Aller*, 220 F.2d, 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Regarding claims 34 and 35, these claims are met for the reasons noted above with regard to claims 18, 23 and 24.

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14. Claims 30 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chou '582 B2 in view of Mansouri and Chou '893 A1 and/or Hahn et al. and/or Murray et al. as applied above, and further in view of Soerens et al. (261 B1).

Chou '582 B2, Mansouri, Chou '893 A1, Hahn et al. and Murray et al. are relied upon as described above.

None of the above disclose adding chitosan to the coating composition.

However, Soerens et al. teach that chitosan is preferably added as a naturally occurring anti-microbial agent (*col. 4, line 22 bridging col. 6, line 24 and examples*). It would, therefore, have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to modify the device of Chou '893 A1 in view of Hahn et al. and/or Murray et al. to include chitosan in the coating composition as taught by Soerens et al., since chitosan is known to be an additive in skin-contacting coatings as a naturally occurring anti-microbial agent.

### ***Response to Arguments***

**15. The Double Patenting rejection of claims 18 - 36 in view of App '580 (alone or in view of Mansouri)**

Applicant(s) arguments have been considered but are moot in view of the new ground(s) of rejection.

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**16. The rejection of claims 18 - 36 under 35 U.S.C § 103(a) – Various references**

Applicant(s) arguments have been considered but are moot in view of the new ground(s) of rejection. In so far as they apply to the present rejection of record, applicant(s) argue\*\*\*

***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Green et al. (U.S. Patent No. 6,280,673 B1) disclose a method for making coated gloves comprising a coating that is hydratable when wetted and includes a polyhydric alcohol moisturizer (*glycerin*) and microporous particles (*Abstract; col. 2, lines 36 – 65; and examples*). Modak et al. (U.S. Patent No. 6,037,386) disclose a coating composition that is activated by perspiration (*entire disclosure*). Modak et al. (U.S. Patent App. No. 2007/0020342 A1) disclose a gel/cream with includes a commercial compound including glycerin and potentially some of the other claimed components (*entire disclosure*). Gould et al. (U.S. Patent No. 6,673,054 B1) disclose a therapeutic coating for skin with a glove (*entire disclosure*). Stockum (U.S. Patent No. 4,853,978) disclose known elastomeric materials (*col. 1, lines 44 – 51; col. 2, lines 34 – 45; and col. 4, lines 17 – 28*) for medical glove use. See attached MSDS for sodium citrate indicating that synonyms include "citric acid".

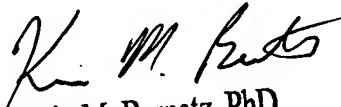
18. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kevin M. Bernatz whose telephone number is (571) 272-1505. The Examiner can normally be reached on M-F, 8:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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KMB  
July 6, 2007

  
Kevin M. Bernatz, PhD.  
Primary Examiner